

REMARKS

This amendment is made in response to the Office Action mailed on July 16, 2007. Claims 1-15 and 17-28 are pending. Of these, claims 15 and 17-20 stand rejected under 35 U.S.C. § 112; and claims 1-15 and 17-27 stand rejected under double patenting and under 35 U.S.C. § 102. Dependent claims 3-6, 12-14, 25, and 26 were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, they have not been rewritten in independent form in this response. Claim 28, which is new, stems from independent claim 21 and finds exemplary support at least at page 80 of the instant application. Thus, no new matter has been added.

A detailed response to the rejections follows and reconsideration is requested respectfully.

Response to §112 Rejections

The Examiner rejected claims 15, and 17-20 under 35 U.S.C. §112, second paragraph, for indefiniteness, specifically noting that “the monitoring” lacked antecedent basis. In response, applicant has amended claim 15 to recite “generating a bill based on the amount of transcription” rather than “the monitoring.” Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the §112 rejections.

Response to Double Patenting Rejection

Claims 1-15 and 17-27 were rejected under the judicially created doctrine of double patenting over claims 1-24 of U.S. Patent No. 5,970,141 (Attorney Docket No. 7962.001US4).

Applicant does not admit that the claims are obvious in view of the above-cited patent. However, a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) is enclosed herewith to obviate these rejections.

Response to §102 Rejections

Claims 1-2, 7-11, 21-24, and 27 were rejected under 35 U.S.C. § 102(b) for anticipation by Wright (U.S. Patent 3,557,927) or Strand (The Computer-Integrated Courtroom: A

Demonstration, Federal Judicial Center, Conference of Chief District Judges, Phoenix, Arizona (Apr. 6, 1989) p. 1-14). Applicant respectfully traverses these rejections as follows:

Regarding claims 1, 2, and 7, applicant submits respectfully that one of skill would not regard either Wright or Strand as identically meeting all the requirements of these claims. For example, claims 1, 2, and 7 recite a method of billing for real time transcription of spoken words to a textual format. Neither Wright nor Strand uses the term “billing” or any term that one of skill would likely understand to concern even the notion of billing.

Secondly, nothing in either Wright or Strand appears to correspond to the joint requirement of “identifying, by the remote system, the computer aided transcription system communicatively coupled thereto” and “communicating, by the remote system, to the computer aided transcription system an authorization for a predetermined amount of transcription.” At best, Wright reports, at column 3, lines 13-17, that its “shorthand machine 10 is modified to produce an electrical output which, in the preferred embodiment of the present invention, is coupled, through a cable, to the tape recorder 11 which produces a record suitable for computer input.” However, nothing in this passage nor any other that applicant found equates to a remote system not only identifying the computer aided transcription system but also communicating an authorization to the transcription system, as claims 1, 2, and 7 require. The Examiner cited columns 3 and 9, and figure 3 in relation to these claims, but nothing in these passages or figures equates to use of a remote system pursuant to the precise identifying and communicating requirements.

Strand, which reports use of a transcription system within the confines of a Novell local-area-network (LAN) linking ten DOS 286 work stations, at page 2 last paragraph, similarly fails. There’s nothing in Strand to one of skill would reasonably equate with anything inside or outside the LAN communicating an authorization for a predetermined amount of transcription to a transcription system.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the 102 rejection of claims 1, 2, and 7.

Regarding claims 8-11, applicant submits respectfully that one of skill would not regard either Wright or Strand as identically meeting all the requirements of these claims. For example,

neither Wright nor Strand provides anything that one of skill would regard as “disabling, by the computer aided transcription system, the transcribing after a predetermined amount of transcription has been reached.” For Wright, the Examiner cites column 9, lines 25-28 as meeting this requirement. However, the passage merely states “The C signal provides the turn-off signal for the motor 130 and the signal should be generated sufficiently late in the commutator cycle to prevent the commutator from stopping before it reaches the first contact.” Thus, it doesn’t appear that one of skill would regard this passage as indicating an act of “disabling transcription after a predetermined amount of transcription.” For Strand, the Examiner cites pages 3-5; however, these pages are completely devoid of the term “disable,” its derivatives, and indeed anything that might reasonably equate to disablement of the transcription system.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the 102 rejection of claims 8-11.

Regarding claims 21-24 and 27, applicant submits respectfully that one of skill would not regard either Wright or Strand as identically meeting all the requirements of these claims. For example, these claims require an act of “automatically indicating for a user of a computer aided transcription system that an amount of real time transcription of spoken words has occurred.” In the Action, the Examiner cites Wright’s column 9, lines 25-28 as meeting this requirement. However, this passage, also cited for claims 8-11, merely states “[t]he C signal provides the turn-off signal for the motor 130 and the signal should be generated sufficiently late in the commutator cycle to prevent the commutator from stopping before it reaches the first contact.” Thus, the passage appears to only concern internal operation of one portion of a stenographic device; it doesn’t teach that any form of automatic indication to a user regarding an amount of transcription. Likewise Strand also fails to meet this requirement. The Examiner cites pages 3-5 as teaching this requirement, but did not identify any specific section or passage that equates to providing an indication regarding an amount of transcription. Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the rejection or alternatively identify with precision how it satisfies the requirement for indicating an amount of transcription.

New Claim 28

New claim 28 stems from independent claim 21 and is believed to distinguish and thus be allowable at least for the same reasons as claim 21. Consideration and allowance of claim 28 is respectfully requested.

RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/422,202

Filing Date: October 19, 1999

Title: DOWN-LINE TRANSCRIPTION SYSTEM USING AUTOMATIC TRACKING AND REVENUE COLLECTION

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Dkt: 7962.006US1

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9593 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

16 Jan 2008

By _____
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 14 day of January 2008.

Name

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Signature